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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/509,789      | 03/30/2000  | HANS-JOSEF STERZEL   | 48428               | 9729             |

26474 7590 04/26/2002

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WASHINGTON, DC 20036

EXAMINER

DOVE, TRACY MAE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1745     | 10           |

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF/10

|                              |                        |                  |
|------------------------------|------------------------|------------------|
| <b>Office Action Summary</b> | Application No.        | Applicant(s)     |
|                              | 09/509,789             | STERZEL ET AL.   |
|                              | Examiner<br>Tracy Dove | Art Unit<br>1745 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 07 December 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 21 and 22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 21 and 22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ . 6) Other: \_\_\_\_\_ .

### **DETAILED ACTION**

This Office Action is in response to the communication filed on 12/7/01. Applicant's arguments have been considered, but are not persuasive. Claims 21-22 are rejected in view of the prior art. This Action is made **FINAL**, as necessitated by amendment.

#### *Election/Restrictions*

Note all previously pending claims (11-20) were cancelled and new claims 21-22 were added. New claim 21 is similar to canceled claim 16. Canceled claims 11-19 required an election of species. Thus, new claim 21 would also require an election of species. Applicant originally elected to prosecute claims 11-19, electing the species represented by formula IIIa in claim 16. It follows that Applicant would still elect the species represented by formula IIIa in new claim 21. This was confirmed by Applicant in a telephone interview with Herb Keil on 4/24/02.

#### *Claim Objections*

Claim 21 is objected to because of the following informalities: it is suggested the "(B)", in line 10, be deleted. Appropriate correction is required.

#### *Priority*

Applicant has filed a verified translation of the priority document. However, MPEP 706.02(b) states that to overcome a 35 U.S.C. 102 rejection:

Perfecting a claim to priority under 35 U.S.C. 119(a)-(d). The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority

document in the application (and an English language translation, if the document is not in English) (see 37 CFR 1.55(a)(3)) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph.

The translation of the priority document does not satisfy the enablement and description requirements of 35 U.S.C. 112, first paragraph. Specifically, in claim 21 “a molar ratio of LiBF<sub>4</sub>:LiPF<sub>6</sub> from 0.1:9.9 to 9.9:0.1” is not supported by the priority document. Thus, the verified translation of the priority document does not overcome the Akio reference.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Narang et al., US 5,830,600.

See Office Action of 7/17/01 for the reasons for rejection.

Claims 21-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Akio et al., JP 10189038.

See Office Action of 7/17/01 for the reasons for rejection.

***Response to Arguments***

Applicant's arguments filed 12/7/01 have been fully considered but they are not persuasive.

No arguments were presented against the Akio reference.

Applicant argues that for one to arrive at applicant's claims, one must select one of many solvents disclosed by Narang and combine it with one of many electrolyte salts disclosed by Narang. Further argued, the claimed invention is not "preferred" by the Narang reference.

Examiner disagrees with Applicant's interpretation of the Narang reference. In col. 3, lines 63-col. 4, lines 14 Narang teaches the solvent of the instant invention. Furthermore, the section of Narang pointed out by Applicant which discloses the solvent (col. 7, lines 59-61) gives specific examples of those represented by Formula I. Note there are only three listed, with the first one listed, tris-(methoxyethyl)phosphate, being the compound represented by formula IIIa in claim 21. Thus, one is not selecting from "many solvents", as asserted by Applicant.

Regarding the teaching of the lithium salt by Narang, Narang is not limited to the examples or preferred teachings. Note that Narang teaches in col. 10, lines 19-27 that "preferred lithium salts include compounds of the formula Li-A, wherein A is an anion which may be...BF<sub>4</sub>...PF<sub>6</sub>...and mixtures thereof". Both LiBF<sub>4</sub> and LiPF<sub>6</sub> are common lithium salts for lithium secondary batteries. See Linden, Handbook of Batteries, page 36.15. Note the list of twelve salts (col. 10, lines 21-22) disclosed by Narang is not considered to be selecting from "many electrolyte salts" as asserted by Applicant.

Claim 13 has been canceled.

**CAROL CHANEY  
PRIMARY EXAMINER**

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is (703) 308-8821. The Examiner may normally be reached Monday-Thursday (9:00 AM-7:30 PM). My supervisor is Pat Ryan, who can be reached at (703) 308-2383. The Art Unit receptionist can be reached at (703) 308-0661 and the official fax numbers are 703-872-9310 (after non-final) and 703-872-9311 (after final).

  
CAROL CHANEY  
PRIMARY EXAMINER

9-25-07